UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/537,361	03/29/2000	David M. Goodman	920476-907233	6985

7590   04/16/2004

Lee Mann Smith McWilliams Sweeney & Ohlson
P O Box 2786
Chicago, IL 60690-2786

EXAMINER
MEHRA, INDER P

ART UNIT	PAPER NUMBER
2666	9

DATE MAILED: 04/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

<table>
<tr><td rowspan="2"></td><td colspan="2" style="text-align:center">Application No.</td><td>Applicant(s)</td></tr>
<tr><td colspan="2">09/537,361</td><td>GOODMAN, DAVID M.</td></tr>
</table>

	Application No.	**Applicant(s)**
Office Action Summary	09/537,361	GOODMAN, DAVID M.
	Examiner	**Art Unit**
	Inder P Mehra	2666

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>*25 August 2003*</u> .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) *1-7* is/are allowed.

6)☒ Claim(s) *8-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4)☐ Interview Summary (PTO-413) Paper No(s). _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: .

DETAILED ACTION

Response to Amendment

1.   This is in response to an amendment A dated 2/26/04 which has been fully considered

and made of record. Based on this amendment, Claims 1-13 are now pending. In view of the

following new ground of rejection, this office action is Non-Final.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

3.   Claims 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Taniguchi et al (US patent No.6,496,518), **hereinafter,** Taniguchi, in view of **Fukasawa** (US

Patent No. 6,094,737).

For claims, 8 and 10, Taniguchi discloses a synchronous transmission

apparatus for use in a synchronous transmission network in which data signals are carried on

transmission paths, refer to figs. 1, 2 and 5; col. 1 lines 10-15 and abstract; the data units being

arranged in container units, (virtual tributary unit (VT)) ,refer to col. 63-65, and abstract; being

associated with respective pointer bits (pointer bytes 13, refer to fig. 9 and 10)which indicate the

position of the container unit with in a respective data frame, the apparatus comprising:

first and second data ports each arranged-----carried on a respective first and second

transmission paths, refer to col. 18 lines 33-45, col. 18 lines 66 thru col. 19 lines 1-5;

a path selection module (multiplexing section), co-operable with each of said first and
second data ports and arranged to select one other and second data ports and arranged to select---
-paths, refer to multiplexing section in abstract, fig. 13, col. 8 lines 15-17 and col. 19 lines 60-67;

Taniguchi does not disclose expressly the following limitation, which is disclosed by
Fukasawa, refer to Fukasawa's reference col. 19 lines 25-28:

"wherein in order to communicate a message--------, said other data port is arranged to
embed said message in one or more pointer bits associated with the path of said second data
signal, said one data port being arranged to determine said message by examining said one or
more pointer bits (checking the bit errors by comparing it with the received test pattern, refer to
Fukasawa,s col. 19 lines 35-40)", refer to , "**detecting the bit errors** of the transmission frame in
this way, -----supplies it to monitoring circuit----as an error count value, thereby *monitoring the
path*", col. 19 lines 15-28.

It would have been obvious to a person of ordinary skill in the art at the time of the
invention to use the capability of, "embed the message in pointer bits". The capability can be
implemented by combining the system as taught by Fukasawa and Taniguchi at the network
control. The suggestion/motivation to do so would have been to test the traffic of circuits to
enable the errors of transmission path to be detected and dealt with quickly, refer to col. 19 lines
38-39.

4.   Claims 9 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over
Taniguchi et a (US patent No.6,496,518)**, hereinafter,** Taniguchi, in view of over **Fukasawa**

(US Patent No. 6,094,737), and further in view of **Lee et al** (US Patent No. 5,790,557),

hereinafter, Lee.

For claims 9 and 11-13, Taniguchi discloses a synchronous transmission

apparatus for use in a synchronous transmission network in which data signals are carried on

transmission paths, refer to figs. 1, 2 and 5; col. 1 lines 10-15 and abstract; the data units being

arranged in container units, (virtual tributary unit (VT)) ,refer to col. 63-65, and abstract; being

associated with respective pointer bits (pointer bytes 13, refer to fig. 9 and 10)which indicate the

position of the container unit with in a respective data frame, the apparatus comprising:

first and second data ports each arranged-----carried on a respective first and second

transmission paths, refer to col. 18 lines 33-45, col. 18 lines 66 thru col. 19 lines 1-5;

a path selection module (multiplexing section), co-operable with each of said first and

second data ports and arranged to select one other and second data ports and arranged to select---

-paths, refer to multiplexing section in abstract, fig. 13, col. 8 lines 15-17 and col. 19 lines 60-67;

Taniguchi does not disclose expressly the following limitation, which is disclosed by

Fukasawa, refer to Fukasawa's reference col. 19 lines 25-28:

"wherein in order to communicate a message--------, said other data port is arranged to

embed said message in one or more pointer bits associated with the path of said second data

signal, said one data port being arranged to determine said message by examining said one or

more pointer bits (checking the bit errors by comparing it with the received test pattern, refer to

Fukasawa,s col. 19 lines 35-40)", refer to , "**detecting the bit errors** of the transmission frame in

this way, -----supplies it to monitoring circuit----as an error count value, thereby *monitoring the*

path", col. 19 lines 15-28.

Both Taniguchi and Fukasawa do not disclose, "the pointer bits including new data flag (NDF) bits", as recited by claims , 9 and 11-13;

Lee discloses, in reference to fig. 7, "the pointer bits including new data flag (NDF) bits", refer to col. 5 lines 1-5.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to use the capability of, "the pointer bits including new data flag (NDF) bits". The capability can be implemented by combining the system as taught by Fukasawa, Lee and Taniguchi at the network port. The suggestion/motivation to do so would have been to test the traffic of circuits to enable the errors of transmission path to be detected and dealt with quickly, refer to Fukasawa's col. 19 lines 38-39.

Allowable Subject Matter

5.   Claims 1-7 are allowed.

6.   The following is an examiner's statement of reasons for allowance:

The prior art does not teach or fairly suggest the limitations of the following claims:

As recited by claim 1 ,

"a message encoding module arranged to determine which of said first and second transmission paths is selected and being co-operable with said second data signal transmission path to adjust at least one of the pointer bits associated therewith to indicate said path selection;

each of said first and second data ports being co-operable with the second data signal transmission path to determine the setting of said at least one pointer bit and thereby to determine which of the first and second data paths is selected".

As recited by claim 5,

""a message encoding module arranged to determine which of said first and second

transmission paths is selected and being co-operable with said second data signal transmission

path to adjust at least one of the pointer bits associated therewith to indicate said path selection".

As recited by claim 6,

"determining, at each of said first and second data ports, the setting of said at least one

pointer bit thereby to determine which of the first and second data paths is selected".

Any comments considered necessary by applicant must be submitted no later than the

payment of the issue fee and, to avoid processing delays, should preferably accompany the issue

fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for

Allowance."

Response to Arguments

7.   Applicant's arguments with respect to claims 1-13 have been considered but are moot in

view of the new ground(s) of rejection.

Conclusion

8.   Any enquiry concerning this communication should be directed to Inder Mehra whose

telephone number is (703) 305-1985. The examiner can be normally reached on Monday through

Friday from 8:30AM to 5:00 PM.

If attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Seema

Rao , can be reached on (703) 308-5463. Any enquiry of a general nature of relating to the status

of this application or processing should be directed to the group receptionist whose telephone

number is (703) 305-4700.

9.   Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, DC. 20231

Or faxed to (703) 872-9314.

Hand –delivered responses should be brought to Crystal Park II, 2121 Crystal drive,

Arlington, VA, sixth floor (Receptionist).

Inder Mehra   4/7/04

April 7, 2004